

REMARKS

Claims 21-23, 25-27, 31, and 33-42 are currently pending in this application. Support for the amendment to claim 40 can be found in the specification at pages 2-5 and Examples 4 and 5. No new issues are raised by this amendment, especially in view of the fact that claims have been presented previously for producing human insulin using DNA encoding the compound of formula I and cleaving that expressed compound with trypsin to yield mono-Arg -insulin which is subsequently cleaved; see particularly claims 22 and 23. Therefore, no new matter has been introduced by this amendment.

This amendment removes the issue of enablement raised by the Examiner as set forth at page 3 of the December 21, 1998 Office Action. In particular, the Examiner stated that claims 40-41 are directed to a method of making mono-Arg-insulin of formula II, but the method includes an additional cleavage step, which would result in formation of insulin rather than mono-Arg-insulin. Applicants' amendment, which includes the recitation of a method for the preparation of insulin, obviates the premise upon which the Examiner's rejection is founded.

Applicants note that claims 40 and 41 were not rejected under 35 U.S.C. § 103(a) as were the other pending claims. However, claims 22 and 23, which are similar claims to 40 and 41, were rejected as unpatentable over Markussen et al. (U.S. Patent No. 4, 916,212) or Markussen et al. (EPO 163,529) either in view of Goeddel et al. (EPO 055,945), Grau (U.S. Pat. No. 4,801,684) and Grau (U.S. Pat. No. 4,639,332) in paragraph 10, at page 5, of the December 21, 1998 Office Action. Applicants address the substance of that rejection in the Appeal Brief that is being filed concurrently herewith, and believe the argument presented there would also apply to claims 40 and

41, if the Examiner by oversight had failed to include claims 40 and 41 in the § 103(a) rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request entry of the foregoing amendment to simplify the issues on Appeal.

If there are any additional fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

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